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AP

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/164,123	09/30/98	MAYER	A GR-97-P-2681

MMC1/0926

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EXAMINER

EATON, K

ART UNIT	PAPER NUMBER
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2823

DATE MAILED: 09/26/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/164,123	MAYER, ALBRECHT
	Examiner Kurt M. Eaton	Art Unit 2823

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) Responsive to communication(s) filed on 12 July 2000.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-11 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-11 and 15-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - a) All b) Some \* c) None of the CERTIFIED copies of the priority documents have been:
    1. received.
    2. received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
    3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	20) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States; and

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuriyama, as previously applied in the office action mailed 4/13/00.
3. Claims 1 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ma.

In re claim 1, Ma teaches in Figures 1-10 a method including providing a first integrated circuit (4) having a terminal (12) and a signal terminal; forming an electrically conductive connection (14) between the terminal and the signal terminal of the first integrated circuit; providing a second integrated circuit (area outside of first integrated circuit) having a terminal (8) that is coupled to a protective structure for protecting against electrostatic discharges; disposing the first and second integrated circuits adjacent one another; electrically connecting the signal terminal of the first integrated circuit to the terminal of the second integrated circuit; and severing the electrically conductive connection severing the electrically conductive connection between the terminal and the signal terminal of the first integrated circuit using an energy pulse {column 3, line 19 – column 8, line 16}.

In re claim 15, Ma teaches wherein the protective structure is provided as a structure that becomes conducting to dissipate electrostatic discharges {column 7, lines 55-60}.

In re claim 16, Ma teaches wherein the energy pulse is provided in the form of a current which is applied to the electrically conductive connection {column 8, lines 6-16}.

In re claim 17, Ma teaches wherein the energy pulse is provided in the form of a laser beam which is applied to the electrically conductive connection {column 7, line 61 – column 8, line 5}.

In re claim 18, Ma teaches wherein the severing step is severed before packaging the first integrated circuit and the second integrated circuit {column 7, line 14 – column 8, line 16}.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuriyama as applied to claims 1-7 above, and further in view of Bozso, as previously applied in the office action mailed 4/13/00.

***Response to Arguments***

6. Applicant's arguments filed 7/12/00 have been fully considered but they are not persuasive.

7. Applicant contends Kuriyama does not teach a step of providing a second integrated circuit having a terminal that is coupled to a protective structure for protecting against electrostatic

discharges because the only protective structure that the reference teaches is the narrow portion (10c) of the conductor strip (10) of the fuse, wherein the narrow portion (10c) acts to prevent non-illustrated electronic components in the load path from being damaged due to high currents (Kuriyama also states non-illustrated components may also be protected by the narrow portion (10c) from excessively high voltage) that may be provided by the power transistor when the transistor becomes heated during operation. The examiner respectfully submits that, by applicants own admission, as noted above, the narrow portion (10c) of Kuriyama “acts to prevent non-illustrated electronic components in the load path from being damaged due to high currents that may be provided by the power transistor when the transistor becomes heated during operation”. High currents and excessively high voltage running through a load path of an integrated circuit are symptoms of an electrostatic discharge. Thus, the narrow portion (10c) of the conductor strip (10) protects non-illustrated electronic components from an electrostatic discharge.

8. Applicant further contends that there is no teaching suggesting that the narrow portion (10c) is specially constructed such that it will be responsive to electrostatic discharge. The examiner respectfully submits that the features upon which applicant relies (i.e., that the protective structure is *responsive* to electrostatic discharge) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, the protective structure of applicants claimed invention is provided to only protect electrostatic discharges, and, as previously pointed out by applicant, the narrow portion (10c) of the conductor strip (10) acts to prevent (i.e., protect) non-illustrated electronic components in the load path from being damaged due to high currents that may be provided by the power transistor when the transistor becomes heated during operation.

9. Applicant's arguments with respect to claims 15-18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Paper related to this application may be submitted directly to Art Unit 2823 by facsimile transmission. Papers should be faxed to Art Unit 2823 via the Art Unit 2823 Fax Center located in Crystal Plaza 4, room 4C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2823 Fax Center number is (703) 308-7722 or -7724. The Art Unit 2823 Fax Center is to be used only for papers related to Art Unit 2823 applications.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Kurt Eaton** at (703) 305-0383 and between the hours of 8:00 AM to 4:00 PM (Eastern Standard Time) Monday through Friday or by e-mail via [kurt.eaton@uspto.gov](mailto:kurt.eaton@uspto.gov).

  
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